

APR. 16. 2004 3:16PM MACPHERSON KWOK CHEN

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MacPherson Kwok Chen & Heid LLP

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APR 16 2004

## FACSIMILE COVER

Date:	April 16, 2004		
To:	USPTO, Examiner James P. Hughes	Fax Telephone #:	(703) 872-9306
		Office Telephone #:	
From:	Jon Hallman	Date Sent:	April 16, 2004
Subject:	10/004,627	Time Sent:	
Client/File:	M-15307 US	Fax Operator:	exh

This transmittal consists of 24 total page(s), including this cover sheet.

### Message:

Please find the following attached:

- Transmittal Letter (in duplicate);
- RCE Transmittal
- Petition Under 37 CFR §1.47(A);
- Request To Correct Inventorship;
- Declaration and Power of Attorney;
- Declaration Of Jennifer Lantz In Support Of The Filing Under Rule 1.47(A); and
- Declaration Of Jonathan Hallman In Support Of The Filing Under rule 1.47(A) with a copy of the March 10, 2004 letter to Meryl Macklin of Cohen & Grigsby, P.C., a copy of the April 5, 2004 letter to Robert Linn of Cohen & Grigsby, P.C., and a copy of the recorded Assignment.

OFFICIAL

If you do not receive all pages, please call (949) 752-7040

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# MacPherson Kwok Chen & Heid LLP

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April 16, 2004

Commissioner For Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Re:      Applicant(s): Howard M. Kingston  
 Assignee: Metam, Inc.  
 Title: Method And Apparatus For Automated In-Process, Isotope Dilution Threshold And Quantification Measurement Mass Spectrometry  
 Serial No.: 10/004,627      Filed: 12/04/2001  
 Examiner: James P. Hughes      Group Art Unit 2881  
 Docket No.: M-15307 US

Dear Sir:

Transmitted herewith are the following documents in the above-identified application:

- (1) Facsimile Cover Sheet;
- (2) This Transmittal Letter (in duplicate);
- (3) RCE Transmittal;
- (4) Petition Under 37 CFR §1.47(A);
- (5) Request To Correct Inventorship;
- (6) Declaration and Power of Attorney;
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No additional fee is required.  
 The fee has been calculated as shown below:

### CLAIMS AS AMENDED

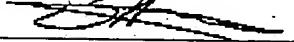
Claims Remaining <u>After</u> <u>Amendment</u>	Highest No. Previously Paid For	Present Extra	Rate	Additional Fee
Total Claims      37	Minus      38	=      0	× \$18.00	\$      0
Independent Claims      4	Minus      5	=      1	× \$86.00	\$      0

### Total additional fee for this Amendment:

<input checked="" type="checkbox"/> Fee for Petition Under 37 CFR 1.47(A)	\$	<u>130.00</u>
<input checked="" type="checkbox"/> Conditional Petition for Extension of Time: If an extension of time is required for timely filing of the enclosed document(s) after all papers filed with this transmittal have been considered, an extension of time is hereby requested.	\$	
<input checked="" type="checkbox"/> Please charge our Deposit Account No. 50-2257 in the amount of	\$	<u>130.00</u>
<input checked="" type="checkbox"/> Also, charge any additional fees required and credit any overpayment to our Deposit Account No. 50-2257	\$	

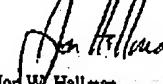
Total:      \$ 130.00

I hereby certify that this correspondence is facsimile transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450, or (703) 872-9306 on April 16, 2004.

  
 Eric Hoover

April 16, 2004  
 Date of Signature

Respectfully submitted,

  
 Jon W. Hallman  
 Attorney for Applicants  
 Reg. No. 42,622

*MacPherson Kwok Chen & Heid LLP*

**COPY**

April 16, 2004

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re:      Applicant(s): Howard M. Kingston  
Assignee: Metara, Inc.  
Title:     Method And Apparatus For Automated In-Process, Isotope Dilution Threshold And  
            Quantification Measurement Mass Spectrometry  
Serial No.: 10/004,627      Filed: 12/04/2001  
Examiner: James P. Hughes      Group Art Unit: 2881  
Docket No.: M-15307 US

Dear Sir,

Transmitted herewith are the following documents in the above-identified application:

- (1) Facsimile Cover Sheet;
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- (3) RCE Transmittal;
- (4) Petition Under 37 CFR §1.47(A);
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No additional fee is required.  
The fee has been calculated as shown below.

**CLAIMS AS AMENDED**

<u>Claims Remaining After Amendment</u>		<u>Highest No. Previously Paid For</u>		<u>Present Extra</u>		<u>Rate</u>	<u>Additional Fee</u>	
Total Claims	37	Minus	38	=	0	x \$18.00	\$	0
Independent Claims	4	Minus	5	=	1	x \$86.00	\$	0

**Total additional fee for this Amendment:**

Fee for Petition Under 37 CFR 1.47(A) \$ 130.00

Conditional Petition for Extension of Time: If an extension of time is required for timely filing of the enclosed document(s) after all papers filed with this transmittal have been considered, an extension of time is hereby requested.

Please charge our Deposit Account No. 50-2257 in the amount of \$ 130.00

Also, charge any additional fees required and credit any overpayment to our Deposit Account No. 50-2257

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Foto: W. G. Schäfer

April 16, 2004  
Date of Signature

Respectfully submitted

Jon W. Hallman  
Attorney for Applicants  
Reg. No. 42,622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Howard M. Kingston

Assignee: Metara, Inc.

Title: Method And Apparatus For Automated In-Process, Isotope Dilution Threshold And Quantification Measurement Mass Spectrometry

Serial No.: 10/004,627 Filing Date: 12/04/2001

Examiner: James P. Hughes Group Art Unit: 2881

Docket No.: M-15307 US

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Irvine, California

APR 16 2004

April 15, 2004

COMMISSIONER FOR PATENTS  
ALEXANDRIA VA 22313-1450

**OFFICIAL**PETITION UNDER 37 CFR § 1.47(A)

Dear Commissioner:

Applicant hereby respectfully petitions pursuant to 37 CFR 1.47(a) in conjunction with a request under 37 CFR 1.48(a) to correct the inventorship and a Request For Continued Examination in the present application.

The present application was filed December 4<sup>th</sup>, 2001 and named Howard Kingston as the sole inventor. He assigned the application to the present assignee on March 27<sup>th</sup>, 2002. A copy of the assignment is attached to this petition. During prosecution of the present application, the assignee hired new prosecuting attorneys and granted them power of attorney as shown by the attached copy of the notice regarding change of power of attorney dated December 9<sup>th</sup>, 2003. Subsequent investigations by the new prosecuting attorneys has revealed that, without deceptive intent, two co-inventors were never named in the present application: Marc Anderson and Ye Han. Accordingly, the present request to correct the inventorship was initiated. As part of this request, a new (or revised) declaration should be signed by all three co-inventors: Howard Kingston, Marc Anderson, and Ye Han. However, as set forth by the following facts, Howard Kingston is refusing to sign this revised declaration.

As set forth in the attached declaration of Jennifer Lantz, the assignee of the present application and Howard Kingston are presently adverse to one another in a declaratory judgment action. As also set forth in that declaration, because of that adversity, it would have

been improper for Jonathan Hallman, a prosecuting attorney for the assignee, to directly contact Howard Kingston to obtain his signature on the revised declaration that is part of the inventorship correction sought by the assignee. Instead, as set forth in the attached declaration of Jonathan Hallman, a copy of the present application, the revised declaration, and a cover letter (a copy of which is attached herein) explaining the need to correct the inventorship in the present application was delivered to Howard Kingston's lawyer on March 10<sup>th</sup>, 2004. As set forth in the attached declaration of Jennifer Lantz, Howard Kingston's lawyer has confirmed that Howard Kingston has received the copy of the application and the revised declaration. However, no indication was given whether Howard Kingston would sign or why he has not signed the revised declaration. As set forth in the attached declaration of Jonathan Hallman, a second copy of the application and the revised declaration was again sent to Howard Kingston's lawyers on April 5<sup>th</sup>, 2004. No response has been forthcoming to this second request.

It is the firm belief of the assignee that, based upon the adversity caused by the declaratory judgment action, Howard Kingston will not sign the revised declaration in support of the inventorship correction sought by the assignee. It is respectfully submitted that the above-described facts establish that Howard Kingston is indeed refusing to sign the revised declaration.

The last known address of Howard Kingston is:

680 Union Avenue  
Pittsburgh PA 15229

The Commissioner is authorized to charge the fees under rule 1.17(h) to our Deposit Account No. 50-2257, and any additional fees that may be necessary.

If there are any questions regarding any aspect of the application, please call the undersigned at 949-752-7040.

LAW OFFICES OF  
MACPHERSON, KWOK CHEN  
& HEID LLP

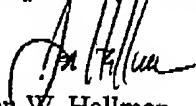
2402 MICHELSON DRIVE  
SUITE 210  
IRVINE, CA 92612  
(949) 752-7040  
FAX (949) 752-7049

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Eric Hoover

April 16, 2004  
Date of Signature

Respectfully submitted,

  
Jon W. Hallman  
Attorney for Applicant(s)  
Reg. No. 42,622